



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,415	04/16/2004	Myong Deok Kim	9988.104.00-US	9371
30827	7590	01/31/2008		
MCKENNA LONG & ALDRIDGE LLP 1900 K STREET, NW WASHINGTON, DC 20006			EXAMINER PERRIN, JOSEPH L	
			ART UNIT	PAPER NUMBER
			1792	
			MAIL DATE	DELIVERY MODE
			01/31/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/825,415

Applicant(s)

KIM ET AL.

Examiner

Joseph L. Perrin, Ph.D.

Art Unit

1792

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 January 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a): The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Joseph L. Perrin/
Joseph L. Perrin, Ph.D.
Primary Examiner - Art Unit: 1792

Continuation of 11. does NOT place the application in condition for allowance because: applicant's arguments are not persuasive.

Regarding the §102(b) rejection over SHUNICHI, applicant initially notes that no translation for the Japanese reference of SHUNICH was supplied and essentially demands a translation from the Examiner. However, the Examiner is taken aback by applicant's position given the fact that 1) applicant cited SHUNICHI in the information disclosure statement of 7/18/2006, and 2) SHUNICH was cited in the previous two actions and only now has applicant taken issue with the reliance of SHUNICHI as a reference. Indeed, since applicant is the one who brought the reference to the Examiner's attention as relevant prior art it would be assumed that applicant has a clear understanding of the submitted prior art reference. Additionally, regarding MPEP 706.02(II), the Examiner notes the first line, which states that "[P]rior art uncovered in searching the claimed subject matter of a patent application often includes English language abstracts of underlying documents, such as technical literature or foreign patent documents which may not be in the English language." As such, SHUNICHI was not found in a prior art search but was supplied by applicant prior to the first action. However, to satisfy applicant's translation request the Examiner has included a translation obtained from the Japanese Patent Office website submitted herewith. Upon thorough review of the translation the Examiner finds no teaching away that would lead one away from the claimed invention and, as such, SHUNICHI is relied upon in its entirety, particularly the Figures which clearly show the hard and soft blocks used as leg pads.

Regarding SHINUCHI, applicant further argues on page 8 of the instant response that SHINUCHI does not anticipate the claimed invention with "one member made of both a low hardness rubber 43 and a high hardness rubber 44, and a separate member made of a third material." However, applicant's arguments are not commensurate in scope with the claimed invention. There is nothing in the claimed invention of a "third" material. On the contrary, the claim recites one member being made of "a block copolymer of hard blocks and soft blocks" and the other made of "a second material". Manifestly, any material not made of hard and soft blocks reads on a second material. Moreover, the generalized and broad recitation of the terms "member" and "material" read on practically anything and any combination of structures, and contrary to applicant's assertion the claimed "members" may be integral or separate. It is of no moment whether the members of SHINUCHI are integral or separate so long as the structural limitations disclosed therein "read on" the claimed invention (note that applicant does not claim the members being separate or integral, in any event, it is well settled that integrating and making separate are generally not considered patentable modifications). Unquestionably, SHINUCHI discloses a first member formed from hard blocks (44) and soft blocks (43), as clearly indicated in the rejection, and a second member (42) NOT formed of hard blocks and soft blocks, i.e. a second material. Even if, arguendo, one were to construe SHINUCHI in the manner alleged by applicant, the various structures and configurations shown in the Figures of SHINUCHI are more than adequate to warrant an anticipation rejection given the broad recitation of terms such as "member" and "material". Thus, consistent with the well-established court findings, recitation of SHINUCHI reads on the claimed invention.

In the bottom paragraph of page 8, applicant persists in the position that SHUNICHI does not disclose the hard and soft blocks as being a "block copolymer". However, applicant provides no showing or evidence to support this position or refute the Examiner's position. As maintained throughout prosecution, the Examiner emphatically disagrees with applicant's position as it is well settled that the law of anticipation does not require that the reference teach what applicant is claiming, but only that the claims "read on" something disclosed in the reference. The Examiner, having a Ph.D. in chemistry, is well versed in the level of ordinary skill in the polymer art and submits that the combination of hard and soft blocks in SHINUCHI reads on the claimed block copolymer of hard and soft blocks claimed. Moreover, the combination of hard and soft block polymers in SHINUCHI appears to solve the same problem of applicant in the use of material in a leg pad for a washing machine. Thus, there does not appear to be any structural difference between the two blocks of SHINUCHI and those claimed or any unexpected result from their use. One having ordinary skill in the art would immediately recognize that the claimed combination of hard and soft blocks "read on" the hard and soft blocks disclosed in SHINUCHI. Thus, the Examiner finds no structural difference between the claimed invention and that of SHINUCHI, much less a patentable difference, and no structural difference is apparent. If applicant believes there is a structural difference applicant is urged to provide evidence to support this conclusion.

Regarding the rejection of claims 2, 3 and 11-14 under §103(a) as being unpatentable over SHUNICHI in view of OGAWA, applicant takes the position that since OGAWA fails to cure the deficiencies of SHUNICHI notwithstanding the fact that OGAWA discloses the exact same rubber materials of butyl rubber and block copolymers claimed for the same use (i.e. for their dampening properties). Thus, applicant does not deny that the materials claimed are well known in the art for their intended purpose of absorbing vibrations. Accordingly, applicant's arguments are not persuasive for reasons of record. Moreover, there is no showing of a patentable difference between the claimed use of known materials for their known use and the disclosure of the known materials for their known use in the art. As such, the record is still not clear of how the claimed combination of known materials for their known use is a patentable modification.

Regarding the rejection of claims 4-7 under §103(a) as being unpatentable over SHUNICHI in view of OGAWA, and further in view of RIEGER, it is not clear what applicant argues. As best understood, applicant simply argues that RIEGER does not disclose the claimed polymers of claim 1. It appears applicant has missed the thrust of the Examiner's rejection. Since RIEGER is not cited for the use of polymers of claim 1, but rather for the teaching of block copolymers of known particular properties as dampening materials in a household appliance. Thus, RIEGER teaches that the selection of the claimed glass transition temperature ranges and shore hardness ranges are known in the art for their intended use of vibration dampening in household appliances as well as the desire to optimize the properties. Simply put, the selection of known materials with known properties to achieve the desired properties for the identical purpose based on optimizing a result effective variable (see *In re Boesch*) renders the claimed range unpatentable for its known purpose of dampening vibration absent unexpected results. Accordingly, there appears to be no patentably distinguishing features of the claimed properties which are known in the art for the intended purpose of providing vibration dampening in a household appliance, and no patentable distinction is apparent.

Regarding the rejection of claims 8-10 under §103(a) as being unpatentable over SHUNICHI in view of OGAWA, and further

in view of YAMAMOTO, applicant argues that the instant invention solves a different technical problem than YAMAMOTO. However, this does not negate the fact that the claimed polymers are known in the art for their intended use of providing vibration dampening. Simply because applicant has a different reasoning for combining does not negate this fact. Since the use of the claimed polymers are known in the art for the intended use of vibration dampening, it would have been well within the level of ordinary skill to select the known materials of YAMAMOTO as vibration dampening polymers. It is of no moment whether the known materials for the known purpose have additional properties since properties are inherent features and do not serve to distinguish in structural limitations which are known in the art.

Regarding the rejection of claim 15 under §103(a) as being unpatentable over SHUNICHI in view of OGAWA, and further in view of DONALD, applicant states that claim 15 is patentable by virtue of its dependency from independent claim 1. This is not persuasive because claim 1 is unpatentable for reasons of record.

It is noted that the prior art of record clearly teaches the known use of the claimed polymers as vibration dampening materials for leg pads in the washing machine art. Thus, it appears that the claimed invention would yield the same predictable results. Absent clear showing of how the claimed invention of known materials for their known intended use result in a patentable modification, the claimed invention is deemed unpatentable for at least reasons of record..